

REMARKS

The present application includes claims 16-20, 22, 103, and 105-127. By this Amendment, claims 16, 105-108, 112-114, 118, and 125 have been amended, and new claims 128-151 have been added.

The Examiner is requested to reconsider the application.

In paragraph 6 of the Office Action, the Examiner has rejected claims 16-20, 22, 103, 105-111, and 114-127 pursuant to 35 U.S.C. Sec. 103. The Examiner contends that these claims are unpatentable over the cited Aravamudan patent in view of the cited Gudjonsson patent.

In paragraph 27 of the Office Action, the Examiner has rejected claims 112 and 113 pursuant to 35 U.S.C. Sec. 103. The Examiner contends that these claims are unpatentable over the cited Aravamudan patent in view of the cited Auerbach patent.

In paragraph 31 of the Office Action, the Examiner has rejected claims 16, 22, 108, 112-114, 118, 122, and 125 pursuant to 35 U.S.C. Sec. 103. The Examiner contends that these claims are unpatentable over the cited Auerbach patent in view of the cited Kim patent and the cited Gudjonsson patent.

In paragraph 46 of the Office Action, the Examiner has rejected claims 17-20, 103, 123, 124, 126, and 127 pursuant to 35 U.S.C. Sec. 103. The Examiner contends that these claims are unpatentable over the cited Auerbach, Gudjonsson, Kim patents in view of the cited Appleman patent.

Application No. 09/385,802
Attorney Docket No. 4031/1, 15719US00

In response to the rejections above that employ Gudjonsson , it is respectfully submitted that it has not been established that Gudjonsson is prior art to the present application and consequently a *prima facie* case of obviousness has not been established. More specifically, the present application's filing date is August 30, 1999. Gudjonsson was filed on May 9, 2000, but claims priority to provisional patent application No. 60/133,401 which was filed on May 10, 1999.

In several of the rejections above, the Examiner cites to the Abstract of the Gudjonsson patent. However, the Abstract is not contained in the provisional patent application and consequently the priority date of the Abstract is May 9, 2000, the date of the filing of the utility application, which falls after the priority date of the present application of August 30, 1999. Consequently, the Abstract does not constitute prior art.

Additionally, with regard to the portions of the issued Gudjonsson patent other than the Abstract that are cited by the Examiner, it is not immediately apparent that the subject matter cited by the Examiner in the issued patent actually appears in the earlier provisional. More specifically, the Examiner cites the issued patent, which is not prior art to the present application, but does not establish that the cited subject matter existed in the earlier-filed provisional patent application. Consequently, the Applicant respectfully submits that there has not been a showing that Gudjonsson constitutes prior art. Thus, no *prima facie* case of obviousness has been established.

Application No. 09/385,802
Attorney Docket No. 4031/1, 15719US00

Further, the contended reason to combine has not been evidenced in the prior art, and consideration is requested for the enclosed declarations of Professor Lee Hollaar and Professor Aviel Rubin.

In paragraph 28 of the Office Action, the Examiner has rejected claims 112 and 113 pursuant to 35 U.S.C. Sec. 103. The Examiner contends that these claims are unpatentable over the cited Aravamudan patent in view of the cited Auerbach patent.

In response, please consider the enclosed Declaration of Professor Lee Hollaar. In light of the Declaration, the Applicants respectfully submit that a *prima facie* case of obviousness has not been established. The rejection is also moot in view of the amendments to claims 112 and 113.

New claims 128-151 are also respectfully submitted to be allowable for the reasons set forth above.

Application No. 09/385,802
Attorney Docket No. 4031/1, 15719US00

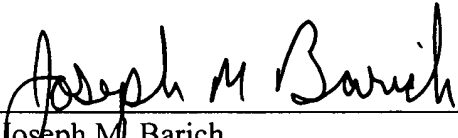
CONCLUSION

If the Examiner has any questions or the Applicant can be of any assistance, the Examiner is invited and encouraged to contact the Applicant at the number below.

The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

Date: October 12, 2006



Joseph M. Barich
Registration No. 42,291

MCANDREWS, HELD & MALLOY, LTD.
500 West Madison Street, 34th Floor
Chicago, IL 60661

Telephone: (312) 775-8000
Facsimile: (312) 775-8100